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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/019,329  | 05/09/2002  | Volker Deichmann     | 112740-372          | 6261             |
| 29177   | 7590        | 03/30/2005           | EXAMINER            |                  |
| BELL, BOYD & LLOYD, LLC<br>P. O. BOX 1135<br>CHICAGO, IL 60690-1135 |             |                      | TRAN, TUAN A        |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 2682                |                  |

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/019,329

Applicant(s)

DEICHMANN ET AL.

Examiner

Tuan A Tran

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 09 May 2002.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 9-16 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 9-16 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. Claims 9-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Holmstrom et al (WO 98/30053) in view of Iwata et al. (6,009,338).

Regarding claims 9 and 15, Holmstrom discloses a mobile phone (See fig. 1), comprising: a nonvolatile memory; an SIM card; at least one electronic telephone directory, one of the at least one of the electronic telephone directory being stored in a memory of the SIM card and another of the at least one of the electronic telephone directory, if applicable, being stored in the nonvolatile memory, a number of attributes including telephone numbers and names of the at least one telephone directory being prescribed by the SIM card (See fig.1, Table 1 and page 3 lines 5-8). However, Holmstrom does not mention that at least one database stored in the nonvolatile memory, each of the at least one database being respectively assigned to one of the at least one electronic telephone directory, wherein each entry of a telephone directory may be assigned to a corresponding database entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry and wherein the at least one database is an expansion telephone directory. Iwata

teaches a mobile phone (See fig. 1) comprising an electronic telephone directory wherein each entry of a telephone directory may be assigned to a corresponding expansion telephone directory entry having a data field of variable size with respect to a number of additional attributes assigned to the telephone directory entry (See figs. 6-7 and col. 14 line 4 to col. 15 line 13). Since both Holmstrom & Iwata teach about the mobile phone having telephone directory, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to apply the teaching of Iwata in creating expansion telephone directories for the electronic telephone directory of the mobile phone as disclosed by Holmstrom for the advantage of allowing users to store additional information associated with the telephone directory.

Regarding claim 10, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each telephone directory is assigned precisely one database (See figs. 6-7).

Regarding claim 11, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each database has a key (in this case, the underlined name) associated with the respective assignment between the database and the associated telephone directory (See figs. 6-7 and col. 14 line 4 to col. 15 line 13).

Regarding claims 12-14, Holmstrom & Iwata disclose as cited in claim 9. Iwata further discloses each of the database entries includes a characteristic diagram which points to the corresponding telephone directory entry in the corresponding telephone directory, wherein the characteristic diagram of the database entry contains the corresponding telephone number and the data field of the database entry contains the

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additional attributes of the telephone number of the corresponding telephone directory (See fig. 7 and col. 14 line 64 to col. 15 line 13):

Regarding claim 16, Holmstrom & Iwata disclose as cited in claim 15. Iwata further discloses the expansion telephone directory stored in the nonvolatile memory differs in format (in term of the amount of data being stored) from the electronic telephone directory stored in the SIM card (See fig. 7). However, they do not mention that the expansion telephone directory being assigned by an IMSI to the electronic telephone directory. IMSI is known as an identification (or the name) of the SIM card, therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to assign the expansion telephone directory to the telephone directory entry represented by the IMSI for the advantage of allowing user to store additional information associate with the SIM card.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Moom (5,768,362); Green (6,501,962); Eichinger et al. (6,370,374).

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **Tuan Tran** whose telephone number is **(703) 605-4255**.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **Vivian Chin**, can be reached at **(703) 308-6739**.

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**Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks

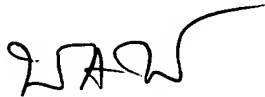
Washington, D.C. 20231

**or faxed to:**

**(703) 872-9314 (for Technology Center 2600 only)**

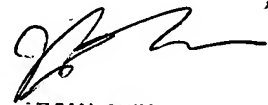
Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.



Tuan Tran

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VIVIAN CHIN  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

3/20/05